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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/547,398	04/11/2000	Hiroshi Satomi	862.C1893	4944

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EXAMINER

MEHRPOUR, NAGHMEH

ART UNIT PAPER NUMBER

2617

DATE MAILED: 12/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/547,398

Applicant(s)

SATOMI ET AL.

Examiner

Naghmeh Mehrpour

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29,31,32,34-36 and 38-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29,31,32,34-36 and 38-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 8/11/06.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed reference listed in the information Disclosure Submitted on 08/11/06 have been considered by the examiner (see attached PTO-1449

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

the claimed invention is directed to non-statutory subject matter.

3. **Claims 36, 42**, are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding **claims 36, 42**. The MPEP in 2106.iv.b.i (b) states:

Data structures not claimed as embodied in computer-readable media are Descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure

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defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

Similarly, computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035. Accordingly, it is important to distinguish claims that define descriptive material per se from claims that define statutory inventions.

Computer programs are often recited as part of a claim. USPTO personnel should determine whether the computer program is being claimed as part of an there wise statutory manufacture or machine. In such a case, the claim remains statutory irrespective of the fact that a computer program is included in the claim. The same result occurs when a computer program is used in a computerized process where the computer executes the instructions set forth in the computer

program. Only when the claimed invention taken as a whole is directed to a mere program listing, i.e., to only its description or expression, is it descriptive material per se and hence nonstatutory. Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process and USPTO personnel should treat a claim for a computer program, without the computer-readable medium needed to realize the computer program's functionality, as nonstatutory functional descriptive material. When a computer program is claimed in a process where the computer is executing the computer program's instructions. When a computer program is recited in conjunction with a physical structure, such as a computer memory, USPTO personnel should treat the claim as a product claim. Nonfunctional descriptive material that does not constitute a statutory process, machine, manufacture, or composition of matter and should be rejected under 35 U.S.C. 101. Certain types of descriptive material, such as music, literature, art, photographs, and mere arrangements or compilations of facts or data, without any functional interrelationship is not a process, machine, manufacture, or composition of matter. USPTO personnel should be prudent in applying the foregoing guidance. Nonfunctional descriptive material may be claimed in combination with other functional descriptive multi-media material on a computer-readable medium to provide the necessary functional and structural interrelationship to satisfy the requirements of 35 U.S.C. 101. The presence of the claimed nonfunctional

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descriptive material is not necessarily determinative of nonstatutory subject matter. For example, a computer that recognizes a particular grouping or sequence of musical notes read from memory and thereafter causes another defined series of notes to be played, requires a functional interrelationship among that data and the computing processes performed when utilizing that data. As such, a claim to that computer is statutory subject matter because it implements a statutory process.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 29, 32, 34-35, 38-41**, are rejected under 35 U.S.C. 103(a) as being unpatentable over Skillen et al. (US Patent 6,098,065) in view of Kambayashi et al. (US Publication 2004/0030656 A1) in further view Chapman et al. (US patent 6,522,421).

Regarding **claims 29, 35**, Skillen teaches a client communication terminal/system having :

a server terminal having:

a **first** storage unit adapted to store content information corresponding to an identification code (col 6 lines 4-47);

a provision unit adapted to provision unit adapted to provide a client communication terminal with message information including the identification code; and

an acquisition unit adapted to acquire from said storage unit content information corresponding to the identification code client communication terminal via a printer via a printer apparatus (col 5 lines 29-67); and
a first transmission unit adapted to transmit to content information to the printer apparatus (col 5 lines 58-67, col 6 lines 1-12);

a client communication terminal having;

an extraction unit adapted to extract the identification code from the message information provided by the provision unit(col 6 lines 39-57, col 6 lines 4-12);

a second storage unit adapted to store the identification code extracted by the extraction unit (col 6 lines 39-57, col 6 lines 4-12);

a second transmission unit adapted the identification code stored in the second storage unit to the server terminal via the printer apparatus (col 6 lines 39-57, col 6 lines 4-12) and

an instruction unit adapted to instruct the extraction unit to execute the extraction process and the second transmission unit to execute the transmission process in response to one operation by using a single physical button (col 6 lines 39-57, col 6 lines 4-12); and

Skillen fails to teach an instruction unit adapted to instruct said extraction unit to execute an extraction process and said first transmission unit to execute a transmission process in response to one operation by using a single physical key. However Kambayashi teaches extraction process and said first transmission unit to execute a transmission process in response to one operation by using a single physical key (col 6 lines 25-45). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine above teaching of Kambayashi with Skillen system, in order to provide a faster system.

Skillen modified by Kambayashi fails to teach that a second transmission unit adapted to transmit the content information acquired by said acquisition unit to a printer: and

a printer apparatus which is connected to the server terminal the printer apparatus having:

a printing unit adapted to print the content information transmitted by said second transmission unit of the server terminal . However Chapman teaches a transmission unit adapted to transmit the content information acquired by said acquisition unit to a printer (col 2 lines 20-67, col 3 lines 1-4); and

a printer apparatus which is connected to the server terminal the printer apparatus having (col 2 lines 20-67, col 3 lines 1-4); and

a printing unit adapted to print the content information transmitted by said transmission unit of a server terminal 30 (col 2 lines 20-67, col 3 lines 1-4).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the

invention to combine above teaching of Chapman with Skillen modified by Kambayashi, in order to provide a mobile to remotely control variety of peripheral devices through user provided inputs.

Regarding **Claim 31**, Skillen modified by Kambayashi fails to teach a system wherein the data is mail data in which the identification code is described. Skillen modified by Kambayashi fails to teach a system wherein the data is mail data in which the identification code is described. However, Chapman teaches that a system that a data is a mail data (col 2 lines 55-66, col 3 lines 35-65). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine above teaching of Chapman with Skillen modified by Kambayashi, in order to provide a more variety to the system by providing mail to the user as well as the other information.

Regarding **Claim 32**, Skillen teaches a system wherein the extraction unit extracts the identification code (user's Id) for a plurality of the data at once (col 5 lines 39-45, lines 64-67, col 6 lines 1-12).

Regarding **Claim 34**, Skillen teaches a system according wherein the client communication terminal 12 further comprising:

a selection adapted to, after the information identification code (advertisement identification) is transmitted by the transmission unit 44 (col 5 lines 17-25), select whether or not the information identification code stored in the second storage unit is

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erased (col 6 lines 26-35). Continually updating of the advertisement 's product showing the possibility of erasing the Identification of the information.

Regarding **Claims 38-39**, Skillen teaches a system according wherein further comprises:

a display unit adapted to display the message information provided by the provision unit (See figure 2, col 4 lines 64-67);

wherein the extraction unit extracts the information identification code in the message information when an instruction is made by the instruction unit while the display unit display the message information provided by the provision unit (col 4 lines 64-67, col 5 lines 1-11, lines 20-38). Skillen modified by Kambayashi fails to teach a system wherein the data is mail data in which the identification code is described. However, Chapman teaches that a system that a data is a mail data (col 2 lines 55-66, col 3 lines 35-65). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine above teaching of Chapman with Skillen modified by Kambayashi, in order to provide a more variety to the system by providing mail to the user as well as the other information.

Regarding **Claim 40**, Skillen teaches a system wherein further comprises:

a receiver unit adapted to receive message information from an external apparatus (col 4 lines 64-67, col 5 lines 1-11, lines 20-38);

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a display unit adapted to display the message information provided by the provision unit (See figure 2, col 4 lines 64-67);

an instruction unit adapted to instruct extraction of an identification code in the message information received by receiver unit and to transmit the extracted identification code to the external apparatus in response to one operation by using a single physical button wherein the identification code specifies content information stored in the external apparatus (col 6 lines 39-57, col 6 lines 4-12);

an extraction unit adapted to extract the information identification code in the message information when an instruction is made by the instruction unit while the display unit displays the message information (col 6 lines 39-57, col 6 lines 4-12) ;

a storage unit adapted to store the information identification code extracted by the extraction unit (col 6 lines 4-47); and

a transmission unit adapted to read from the identification code stored in the storage unit and to transmit to the external apparatus when an instruction is made by the instruction unit in an initial state of display by the display unit (col 4 lines 64-67).

Regarding **Claim 41**, Skillen teaches a system wherein further comprises:

a receiver step of receiving step of receiving message information from an external apparatus;

a display unit adapted to display the message information provided by the provision unit (See figure 2, col 4 lines 64-67);

an instruction step of instructing of an identification code in the message information received in the receiving step and to transmit the extracted identification code to the external apparatus in response to one operation by using physical button, wherein the identification code3 specifies content information stored in the external apparatus;

an extraction step of extracting the information identification code in the message information when an instruction is made in the instruction step while display step displays the message information;

a storing step of storing the information identification code extracted in the extraction step (col 6 lines 4-47);; and

a transmission step of reading from the identification code stored in the storage step and transmitting to the external apparatus when an instruction is made in the instruction step in an initial state of display in the display step (col 6 lines 39-57, col 6 lines 4-12).

Response to Arguments

6. Applicant's arguments with respect to claims 29, 31-32, 34-36, 38-42, have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any responses to this action should be mailed to:

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naghmeh Mehrpour whose telephone number is 571-272-7913. The examiner can normally be reached on 8:00- 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold be reached (571) 272-7905.

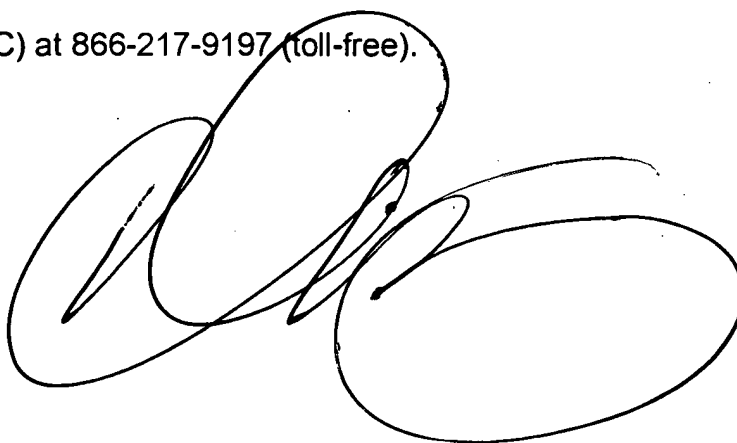
The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NM

December 7, 2006

A large, stylized handwritten signature in black ink, consisting of several loops and a long horizontal stroke.